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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/955,606 | 09/18/2001 | Ralph W. Wright | A148 1601 | 1143 |

7590 10/17/2003

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| EXAMINER |
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GOFF II, JOHN L

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| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,606

Applicant(s)

WRIGHT ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,31,33-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 1-6,8-17,21-30,42 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,31,33-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 18-41, and Species II, claims 18, 31-42, and 44, in Paper No. 4 is acknowledged. It is noted claims 7, 18, 19, and 32 were cancelled, new claim 42 is readable on Species I, and new claim 43 is readable on Species II. The examined claims are 18, 31, 33-41, 43, and 44, and the withdrawn claims are 1-6 and 8-17 directed to the apparatus and 21-30, 42, and 45 directed to Species II. The traversal is on the ground(s) that "The process of amended claim 18 cannot be practiced by another materially different apparatus or by hand. The apparatus of amended claim 1 cannot be used to practice another and material different process. Therefore, the restriction requirement must be withdrawn." This is not found persuasive because the apparatus as claimed can be used to practice another and materially different process such as pressing and/or holding a substrate, e.g. the apparatus could be a flat press, a brick, a paperweight, etc.

Drawings

2. New formal drawings are required in this application because the formal drawings submitted by applicant on 9/18/01 are objected to by the Draftsperson (See PTO-948). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 18, 31, 33, 35-41, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Specification pages 1-3) in view of Brenot et al. (U.S. Patent 5,569,419).

The admitted prior art is directed to methods for forming decorative laminate surface coverings. The admitted prior art teaches the surface coverings comprise a substrate, e.g. a felted or matted fibrous sheet of overlapping, intertwined filaments or fibers, covered with a substantially uniform layer of a liquid or semi-liquid resinous composition containing a synthetic polymeric material and a blowing or foaming agent. The admitted prior art teaches a texture/gloss may be either mechanically embossed by pressing a pattern/texture into the surface covering or chemically embossed by using foam retarding agents to restrict expansion of the

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foamable layer in specific regions of the design. The admitted prior art teaches the mechanical embossing comprises using embossing rolls or plates, i.e. dies, which press against and into the surface covering under relatively great pressure to obtain a desired embossed decorative or textured surface. The admitted prior art teaches the embossed decorative texture may be in register with a printed design located on the surface covering (Page 1, lines 11-23 and Page 2, lines 1-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the embossing die taught by the admitted prior art a reusable/resoluble die on a backing as it was well known in the art to form a pressing, i.e. embossing, die from a reusable/resoluble material deposited on a backing such that after using the dies they can be recycled to make new dies as shown for example by Brenot et al.

Brenot et al. disclose a method for forming reusable dies (and molds). Brenot et al. teach a continuous method comprising dispensing a soluble slurry of filler and binder onto a first conveyor belt (backing), shaping the slurry into a plurality of solidified dies, contacting the dies with a substrate to texture the substrate, removing the dies from the textured substrate by depositing the dies onto a second conveyor belt, and recycling the dies in a holding bin. It is noted that while Brenot et al. depict, e.g. in the Figures, the process in relation to forming reusable molds, Brenot et al. also discloses the process is also used to form reusable dies (Column 1, lines 8-67 and Column 3, lines 1-33).

Regarding claim 34, it is noted Brenot et al. teach applying the slurry to the first conveyor belt followed by shaping the slurry to form the die. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to apply the slurry material to the first conveyor belt in the shaped pattern using a technique such as screen printing

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as direct pattern techniques such as screen printing are well known in the art for applying a slurry in a controlled pattern.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art and Brenot et al. as applied to claims 18, 31, 33, 35-41, 43, and 44 above, and further in view of Moore et al. (U.S. Patent 5,262,100).

The admitted prior art and Brenot et al. as applied above teach all of the limitations in claim 36 except for a specific teaching of using a biodegradable binder. However, it is noted Brenot et al. are not limited to any particular binder material such that it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to use as the binder taught by Brenot et al. any of the well known binders known in the reusable mold/die art such as gelatin, starch, etc. as shown for example by Moore et al. as only the expected results would be achieved.

Moore et al. disclose reusable cores used to mold articles. Moore et al. teach the cores comprise binder, e.g. gelatin, starch, etc., and filler materials (Column 1, lines 11-13 and Column 3, lines 2-3, 31-32, 36-40, and 44-47 and Column 4, lines 38-44).


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff



JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300